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Remark:

(A) Back ground information:

- (1) The subject application had been examined by two examiners and exchanged with over nine rounds of office actions and responses. The applicant had been trying very hard to understand how the office action interpreted the cited prior art and how each claim characteristic of the subject application is found in the subject prior art. It seems up to the latest office action received, the office action is still unable to present a clear picture identifying how every claimed characteristic is disclosed by the prior art, according to the explicit requirement of the patent law.

- (2) Listed below is a recitation of MPEP 2112.02 mentioned on page 3 of applicant's response dated 04/15/2009:

2112.02 Process Claims

PROCESS CLAIMS — PRIOR ART DEVICE ANTICIPATES A CLAIMED PROCESS IF THE DEVICE CARRIES OUT THE PROCESS DURING NORMAL OPERATION

Accordingly it is strongly emphasized that the examiner is required to make sure that prior arts Spackova and Aisaka disclosed the claimed limitations "during their normal operations" as recited in their disclosure. Listed below is a quotation of

37 CFR 1.104(b) and MPEP 707.07:

*Completeness and clarity of examiner's action.
The examiner's action will be complete as to ALL matters.*

According to 37 CFR 1.104(b) and MPEP 707.07, the office action is reminded to note that it is proper for the applicant to demand clear explanation how each claim limitation is interpreted, and how this interpretation is exactly located in the figure and element numbers of the drawings, or in the wording description in column and line numbers of the prior art specification.

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- (3) The applicant had tried very hard in his latest several rounds of responses trying to clarify the ground of rejection. The applicant had quoted support of patent law, quotation of MPEP and precedent court rulings why the request made by the applicant should be honored. Some of the followed up office actions had ignored the solid patent law, MPEP quotations or precedent court rulings quoted by the applicant without informing why the teaching of the quoted patent law, MPEP quotation and precedent court ruling were improper. Listed below is a quotation of MPEP 707.07(f):

Answer all material traversed:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

The examination process without providing response to all traverses accompanied by quotation of supporting law quoted makes it extremely difficult to further revise the claims or arguments for allowance.

- (4) A new ground of rejection under 35 USC 101 had been added to the latest office action.

(B) Rejection under 35 U.S.C. 101:

Claims 40 and it's dependent claims 6, 7, 9-18, 49 and 52 are rejected under 35 U.S.C. 101, as a new ground of rejection. The reason to support this new ground of rejection, as recited by page 3, second paragraph of the office action is quoted below for reference:

An example of a method claim that would not be qualify as a statutory process would be a claim that recited "purely mental steps". Thus, to qualify as a 35 U.S.C. 101 statutory process, the claim should:

- (a) positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or*
- (b) recite the subject matter that is being transformed.*

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The subject independent claim had clearly recited the limitation of "measuring in length unit each of said m defined parameter a physical dimension of said (human) body to produce m values". Since the claim limitation clearly recites a step that involves the interaction with a human body, therefore the subject claims are **NOT "purely mental steps"** as alleged by the office action. Accordingly the ground of rejection is respectfully requested to be withdrawn.

Secondly, the subject application did recite that the subject matter being transformed are the m parameters measured in unit of length. The m parameter measurements are transformed into a single multiple digits compressed BP code, that squarely satisfied the In re Bilski inquiry. Due to the above two solid evidences provided, the new ground of rejection under 35 U.S.C. 101 is respectfully requested to be withdrawn.

(C) Updated fundamental review of 35 U.S.C. 103(a):

The latest patent law requires obviousness issues of 35 U.S.C.103(a) to be evaluated under the teaching of precedent court ruling *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) – herein abbreviated as the "Graham inquiry":

Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (a) Determine the scope and content of the prior art; and*
- (b) Ascertaining the differences between the claimed invention and the prior art; and*
- (c) Resolving the level of ordinary skill in the pertinent art for the obvious combination or modification.*
- (d) Evaluate other objective evidence and secondary considerations relevant to the issue of obviousness*

When a claim is to be rejected under 35 U.S.C.(a), the consideration of precedent Supreme Court ruling *KSR Int'l Co. v. Teleflex Inc.* #04-1350 in 2008 should be carefully considered. In this precedent court ruling, the Supreme Court had ruled out the use of rigid explicit TSM test inconsistent with the case law of the Supreme Court to prove that a claim is not obviousness. The Supreme Court further required a court or an examiner to follow the Graham inquiry and to provide clear articulation to prove that the combination is reasonable. The following sessions are provided to compare the

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previous examination process with the inquiries of Graham and to determine if the examination process is proper to conclude that the subject claims are obviousness.

(D) Implementing the Graham Inquiry:

Listed below is a quotation of MPEP 2141.02 VI

PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)

According to MPEP 2141.02VI and precedent court ruling *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, the prior art Spackova and Aisaka are to be evaluated "In its entirety" to determine their scope and content as indicated in the inquiry of Graham, step (a) of section (C) herein. According to MPEP 2112.02, section (A)(2) herein, because the subject claims are process claims, only the normal operation of Spackova and Aisaka are to be evaluated to determine the scope and content of these two prior arts. Listed below are the findings according to above step (a) of the Graham inquiry:

(1) The prior art Spackova:

(a) Evaluation of Spackova according to step (a) and (b) of the Graham inquiry:

The office action carried out the first step (a) of the Graham inquiry by indicating that the scope and content explicitly disclosed steps (1) and (2) of independent claim 40. As repeated in previous responses, the applicant had pointed out that the office action failed to provide solid evidence to support this conclusion. This is because the office action failed to exactly identify the explicit location (drawing, element numbers, column and line numbers) of the Spackova that explicitly disclosed the existence of the following four claimed limitations during her normal operation:

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- (i) Precisely point out what are the m different physical dimensional parameters interpreted in Spackova and where these interpreted parameters are exactly located in the disclosure of Spackova?
- (ii) Indicate where in the disclosure of Spackova, describing how these physical dimensional parameters are reasonably required in the normal operation process of Spackova (MPEP 2112.02 requirement)?
- (iii) Indicate where in the disclosure of Spackova, describing how these physical dimensional parameters in length units are measured in the normal operation of Spackova;
- (iv) Point out where in the disclosure of Spackova, describing the m measured values claimed can be obtained from the normal operation of the device of Spackova.

Carefully reading the ground of rejection about the limitations (a) to (d) above, the examiner seems to conclude that the system of Spackova is obvious to be capable of performing the limitations (i) to (iv) above. If this is the case, the examiner is respectfully requested to note that step (a) of the Graham inquiry is to determine the original scope and content of the prior art recited in it's drawings, columns and lines of the specifications. The evaluation if the system of Spackova is obvious of performing the claimed limitations (a normal operation process according to MPEP 2112.02 requirement) belongs to step (c) of the Graham inquiry. Although the office is still failed to provide locations of reference drawings, column and line reference, and explain how the conclusion of "scope" provided in the office action was derived, the applicant respectfully submit the result of Graham step (a) inquiry as follow:

Spackova in it's entirety, disclosed the "normal operation process" of a previewer provided for the dynamic viewing of an article desired to be worn by the user in a complete series of poses without actually trying on the article.

On page 7, last paragraph of the latest office action, the examiner also explicitly agreed with the recitation:

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Spackova describes the design and operation of a system that enables users to preview articles of clothing without actually trying on the article.

Evidences of the above scope interpretation was found in the complete Abstract and Summary of the Invention of Spackova, as well as the explicit acknowledgement of the office action. MPEP 2112.02 recited in section (A)(2) above provided another condition how the scope of the prior art Spackova should be formulated. As a further step, the content of Spackova should commensurate with this scope identified, unless the examiner is able to quote drawing, column and line reference to prove that Spackova did disclosed all the four recited characteristics (i) to (iv). If the examiner still does not agree on this result of the Graham step (a) inquiry, the examiner is required to provide "stronger" evidence, supported by the drawing, column and line location of Spackova, how the above claim limitations (i) to (iv) are found in the content of Spackova, a requirement of the Graham inquiry. On page 9, first paragraph, the office action recited that:

Applicant apparently wants a one-to-one, verbatim matching between the instant claims and the prior art. However, this is not possible due to differences in terminology, the nature of the rejection (which combines teachings from multiple references in this case), and actual differences in the inventions themselves. No amount of explanation or comparison can overcome a difference of opinion held between the examiner and applicant regarding the interpretation of what is being claimed and what is disclosed by the prior art.

The above explicit recitation of the office action concludes the inability for the office action to provide clear interpretation of claim limitations, to precisely locate these interpretations in the cited prior art and to provide one-by-one prior art comparison because:

- (a) a one-to-one verbatim matching between the instant claims and the prior art is improper;
- (b) Clear limitation comparison is impossible due to differences in terminology;
- (c) Clear limitation comparison is impossible because multiple references are combined to provide the ground of rejection;

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- (d) Clear limitation comparison is impossible due to differences in the invention themselves; and
- (e) No amount of explanation or comparison can overcome a difference of opinion held between the examiner and applicant regarding of what is being claimed and what is disclosed by the prior art.

The applicant respectfully provide the following argument to traverse the subject recited position of the office action:

For reason (a), one-to-one verbatim matching between the instant claims and the prior art is **"one of the many acceptable forms"** to conduct the first two steps of the Graham inquiry. If one-to-one verbatim matching is not possible, the applicant can accept "other ways" that clearly identify how each claim limitation is precisely located in the disclosure of the prior art. For example, it is acceptable for the examiner to provide alternate wording pointing out that the belt of the figure without the indicia in FIG. 3 is the first parameter, and the distance between the indicia 72 and 74 is the second parameter.

For reason (b), the office action erred in holding a position that differences in terminology disable the ability for an office action to provide clear comparison for each claim limitation. The applicant can accept different terminology as long as the office action clearly indicates how each terminology of the prior art is equated to a term used in a claim. For example, the applicant can accept the statement that "the eye glass 21 of FIG. is equivalent to the first parameter recited and the indicia 74 is equivalent to the second parameter recited. Cross matching of different terminology is acceptable as long as they are clearly expressed in the office action.

For reason (c), the examiner is respectfully requested to note that the Graham inquiry emphasized by the Supreme Court requires clear claim limitation comparison with each prior art, before the prior arts are evaluated if their combination is obvious. Therefore the situation of reason (c) does not exist in the early steps of the Graham inquiry. It is also important to note that

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If explicit one-to-one comparison of claim limitation is not conducted, the early steps of the Graham cannot be completed.

For reason (d), the office action explicitly acknowledges that clear comparison for each claim limitation is impossible due to differences in the invention themselves. If the office action is true that the differences in the subject claimed invention and the prior art is so great that clear claim comparison is impossible, then this is a strong evidence of non-obviousness.

For reason (e), the office action erred to indicate that clear explanation and claim limitation comparison is impossible due to difference in opinion between the examiner and the applicant. The requirement to provide clear claim limitation comparison is a matter of law and not a matter of opinion. The difference in opinions is to be resolved by law. The difference in opinion is to be resolved with recitation of proper supporting law, MPEP and precedent court ruling. If one party feels that the quotation of law, MPEP and precedent court ruling provided by another party is improper, the party should clearly providing reasons informing the other party why the law supported reasons quoted was wrong. The applicant quoted 37 CFR 1.104(b) and steps (a) and (b) of the Graham inquiry to prove that it is the law that requires an office action to clearly show how "each claim limitation" is located in the prior art.

As a conclusion of this section, it is a fact that the previous office actions failed to clearly identify how each of the four claimed limitation (i) to (iv) above are performed during the normal operation of Spackova. The office action failed to clearly identify where the drawing, element numbers, column and line location of Spackova are found to disclose the subject claim limitations. Because the office action failed to inform the applicant how each claim limitations (i) to (iv) or their interpretations are located in the disclosure of Spackova, the applicant is unable to complete the Graham inquiry, and to provide a proper response nor to argue if the interpretation is correct.

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(b) Evaluation of Spackova according to step (c) of the Graham Inquiry:

There are significant differences in the meaning of patent law to distinguish the first situation if Spackova did recited the claim limitations (i) to (iv) in her normal operation as compared with the second situation that Spackova did not recited all the limitations (i) to (iv) but instead provided a system that is obvious to be applicable for the claim limitations (i) to (iv). If the examiner is able to clearly demonstrate that Spackova's normal operation had indeed recited all the limitations (i) to (iv), then the applicant needs to conduct argument according to terms interpretation rules provided by the patent law. If the conclusion of the office action is that Spackova's normal operation did not recited the claimed limitations but the Spackova system is obvious to be capable of performing the claimed limitations, then the applicant is required to prove that obviousness does not exist, a completely different strategy to properly structure an argument.

The subject issue is that the various office actions, even after repeatedly urged by the applicant with the support of 37 CFR 1.104(b), still failed to clearly identify how each claim characteristic (i) to (iv) is found in the prior art Spackova as required by the Graham inquiry, therefore the applicant is unable to proceed to evaluate step (c) of the Graham Inquiry. The latest office action explicitly indicated that no amount of explanation or comparison to resolve the subject issue is possible. Because the subject issue is an examination procedural issue that cannot be appealed, the only option is to resolve the issue is a petition to director for a neutral third party opinion.

The examiner is respectfully requested to wait for the result of the petition before issuing an office action.

(2) The prior art Aisaka:

The situation of the prior art Aisaka is much better than that of Spackova. The office action had provided adequate information for Aisaka to be analyzed according to the Graham Inquiry. First of all, it seems the office action had not

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conducted a comprehensive Graham inquiry as indicated in section (C) herein. Listed below is a Graham inquiry of prior art Aisaka, which forms the base of applicant's argument. The examiner is respectfully requested to examine the submitted Graham inquiry in detail. If the examiner notices any part of the Graham inquiry presented is of error, the examiner is respectfully requested to point out the error discovered, and law supported evidences (quotation of appropriate patent law, MPEP recitation or precedent court ruling) to prove that an error did happen in the Graham inquiry submitted. The examiner is particularly directed to the quotation of MPEP 2112.02 recited in section (A)(2) above and also MPEP 2141.02 VI of section (D) above. According to MPEP 2112.02 and MPEP 2141.02VI, steps (a) in the Graham inquiry of Aisaka should be evaluated according to the normal operation process of the device of Aisaka and when Aisaka is considered in its entirety. Listed below is a step-by-step presentation of Graham's inquiry of Aisaka.

(a) Scope of Aisaka:

The scope of Aisaka is related to a device easy and accurate measurement of garments, making use of a standard body having a plurality of contact pieces and sensors (Summary of Invention, col. 1, lines 34-51).

(b) Content of Aisaka:

The content of the prior art Aisaka is the operation process of the device of Aisaka as summarized in col. 1, lines 52-64 and as demonstrated by the drawings of the drawings Fig. 1 to Fig. 6. A further content of Aisaka that may commensurate with the subject application is col. 1, lines 7-20, about the standard JIS garment size indicators, which forms the ground of obviousness rejection according to page 5, 3rd paragraph of the latest office action.

There exists "an interpretation issue" between the examiner and the applicant. The examiner and the applicant had different interpretations about the content of Aisaka. The examiner interpreted the disclosure of Aisaka to disclose a sizing system (of sizes No. 5, M, XL etc.) of an actual "wearer's body", and the measurements of the body (waist, chest, height etc.) are

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compressed into a single code (e.g. M or size 42) that represents the overall body profile. As for step (a) of Graham's inquiry, the applicant interpreted that the actual system of Alsaka is for measuring the sizes of garment. It is not a sizing system for human body. The normal operation process of Alsaka is to measure the dimensions of a garment, and then determine which size indicator the garment will better fit (of sizes No. 5, M, XL etc.). This issue is to be resolved according to factual findings of a throughout study of Alsaka. The applicant had provided a factual analysis of this issue in sections (C)(a) and (C)(b) of his response dated 05/05/2008. Although the subsequent office action did not agree with the factual analysis presented, the subsequent office action dated 12/16/2008 failed to provide any clarification why the factual analysis provided by the applicant was wrong. This "interpretation issue" must be resolved by a proper Graham inquiry. Listed below is a summary of factual evidences that supports the interpretation of the applicant. The examiner is strongly urged to reconsider if the interpretation evidences submitted herein are proper, and if not, providing evidence proving why it is not proper:

Evidence (i): Explicit acknowledgement of Alsaka

Listed below is a recitation of Alsaka in col. 1 lines 34-35:

An object of this invention is to provide a device for easy and accurate measurement of garments.

It means Alsaka explicitly acknowledged it's invention is for measurement of garment sizes.

Evidence (ii): Human body is not involved in the normal operation process of Alsaka

Throughout the disclosure, human body is not involved in the normal operation of the device of Alsaka. Accordingly measurement of human body is not the subject matter to be serviced by Alsaka's device.

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Evidence (III): Garment 13 of Fig. 6 is the subject matter of Aisaka's device

If the garment 13 of Fig. 6 is removed from the operation of Aisaka, no measurement by the device 1 of Aisaka will be possible. This is strong evidence that the device of Aisaka is for measurement of a garment represented by 13, instead of a human body.

After the garment measurement is completed, the measurement is computed by the arithmetic device 11 to determine which standard garment size (No. 5, No.9 or size S, M and L) the garment 13 will better fit. Accordingly to the above submitted evidences, the interpretation recited in page 5 third paragraph of the latest office action is erroneous. Proper Graham Inquiry about the content of Aisaka is about "a device provided to measure dimensions of a garment, and a computing device 11 is configured to determine which size of a garment size chart the garment is of closest fit. The portion of Aisaka disclosure best commensurate with the subject claims is a standard garment size chart having predefined standard sizes represented by 5, 9, or S, M or L etc."

The applicant had provided undisputable Evidences (i) to (iii) above to prove that the interpretation indicated in page 5, 3rd paragraph of the latest office action is erroneous, and that the above underlined interpretation should be a more proper content to represent Aisaka. If the examiner does not agree with the above-mentioned Graham inquiry, the examiner is respectfully requested to provide stronger evidence why applicant's Graham inquiry is wrong and why the interpretation indicated in page 5, 3rd paragraph of the office action is more proper.

(3) Graham's Inquiry to combine Spackova and Aisaka

As concluded in section (D)(1) above, the office action failed to provide according to 37 CFR 1.104(b), a clear interpretation how the claim limitations (i) to (iv) of section (D)(1)(a) can be located in the disclosure of Spackova.

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Accordingly it is impossible to conclude that Spackova did disclose the limitations (i) to (iv) in it's content.

"Assuming" that the examiner is able to indicate where in the content of Spackova, all the claim limitations can be located and that the indication is not disputed, the material in front of step (b) of the Graham inquiry is to "*Ascertaining the differences between the claimed invention and the prior art*". This is to evaluate the differences between the further limitations of the claimed invention and the step (a) inquiry content of Aisaka:

Further claim limitation of claim 40:

Listed below is a recitation of further claim limitation of claim 40:

"Processing said m values (of human body parametric measurements) to produce a multiple digits compressed BP code for representing said m values."

This claim characteristic is to be compared with the most commensurate content of Aisaka as follow:

"a garment size chart having predefined standard sizes indicators represented by 5, 9, or S, M or L etc., each related to predefined measurements of a garment."

The differences identified according to step (b) of Graham's Inquiry are as follow:

- (a) The claim limitation is about human body dimensional measurements and that of Aisaka is about garment dimensional measurement;
- (b) The claim limitation is about a "compressed" BP code, and the "compressed" code is obtained by processing m values of a human body measurements. The codes (sizes 5, 9, S, M and L etc.) of Aisaka is about the standard size indicators defined by a standard maintaining organization such as JIS.

The next step of Graham's inquiry is to "*Resolve the level of ordinary skill in the pertinent art for the obvious combination or modification*". The modification required here is to learn from the "normal operation" [required by MPEP 2112.02 recited in section (A)(2) herein] of standard garment size indicators (sizes 5, 9, S, M and L etc.) provided by a standard garment size chart or system as disclosed

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by Aisaka and to modify it into a method to process the body measurements of a human body into a multiple digits "compressed code". Over here it is necessary to distinguish the characteristics of standard garment size indicators and the disclosed properties of the "compressed code" of a human body, according to a person having ordinary skill in the art. One well-known characteristic of standard size charts for garments is that it contains limited number of size indicators. For example, the standard size indicators of S, M, L system is an industrial standard limited to 10 indicators of XXS, XS, S, M, L, XL, XXL, 3XL, 4XL and 5XL. The British BS garment size chart standard defined 13 standard size indicators. Most international recognized size standards had defined less than 20 size indicators in its standard. In contrast to the fixed size chart standard for garments as disclosed in Aisaka, the goal of the subject invention is to provide a more comprehensive size description system of a human body, which processes the actual body measurements of a human body into a "compressed code". Understanding the art recognized background of standard garment sizing system set by a standard institution such as JIS or BS, and the subject invention of a method to process actual human body measurements into a compressed code is important. The following evidences proved that it is unobvious to transform a trade recognized garment sizing standard into a method as claimed:

Evidence (a): Modification consideration

It seems the office action is taking a position that it is obvious for the number of standard garment size indicators of Aisaka to be "freely expanded" so that there is no difference between the standard size indicators of Aisaka as compared with that of the compressed BP code claimed. The view of a person having ordinary knowledge in the art towards this obviousness interpretation is important. The evaluation can be conducted according to two extreme conditions of comparing the two systems:

- (i) Is it obvious for a person having ordinary knowledge in the art to use the claimed method to process the body measurements of a human body into generating the less than 20 standard size indicators of Aisaka? The answer is obviously no because with fewer than 20 standard size

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indicators, there is actually no need to conduct the compression process as claimed.

- (ii) Is it obvious for a person having ordinary knowledge in the art to expand the garment sizing standards of Aisaka (with less than 20 size indicators in the standard garment size chart) into a wide range system of the claimed compressed BP code. The answer is also obviously no because doing so, there will be too many sizes for garments to be handled by garment suppliers in the retail stores when the modified system is introduced to the retail field.

Evidence (b): Source of the code

A person having ordinary knowledge in the art knows that the size indicators of Aisaka are industrial standards controlled by industrial standard maintaining or setting organizations such as BS or JIS as mentioned in Aisaka. It means the size indicators are "rigid standards" that cannot be altered nor freely expandable as indicated by the office action. It also means that the garment size indicators are strictly defined by the standard setting organizations (JIS in the case of Aisaka) and not to be generated by the method as claimed. Therefore the obviousness interpretation of the office action (obvious to alter the industrial garment size indicator standard) can never happen in the real world when the background nature of the sizing system disclosed in Aisaka is fully understood and considered. Listed below is a recitation (col. 1, lines 8-11) of prior art Aisaka referenced by the office action:

In Japan, the sizes of ready-made garments are "fixed" by Japanese Industrial Standards (JIS) and are indicated by numerical symbols such as No. 5 and No. 9 or by alphabetic symbols such as S, M, and L, for example.

The above recitation of Aisaka about the symbols No. 5 and No. 9, S, M and L had been specifically quoted on page 5, 3rd paragraph of the office action to support the ground of obviousness rejection. The examiner is particularly directed to note that Aisaka had explicitly acknowledged that the evidence specially quoted by the office action to support the ground of rejection is actually "fixed" by Japanese Industrial Standards (JIS). The explicitly acknowledgement

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of Aisaka that the garment size indicators referenced by the office action are "fixed" by industrial standard organization teaches away the interpretation of the office action. This is because the interpretation of the office action was built upon the assumption that the "fixed" standard garment size indicators of Aisaka can be modified or expanded to become a compressed BP code as claimed. A modification that render the prior art inoperable is an evidence of non-obviousness. See MPEP 2143.01V and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The proposed modification cannot change the principle of operation of prior art Aisaka. See MPEP 2143.01VI and *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Evidence (c): Inconsistent result of the garment size system of Aisaka

As analyzed in section (D)(2) above, the content of Aisaka describes a device configured for measuring the parameters of a garment. The measured values are then analyzed by an arithmetic unit 11 to determine which garment standard size indicator better fits the physical size of the garment. There reasonably happens that some inconsistency exists in this system as one parameter such as sleeve measurement of the garment may indicate the garment should be of size M; while the measurement of another parameter such as neck circumference may direct the garment to belong to the size L. In addition, Aisaka explicitly acknowledged in col. 1, lines 14-18 of his specification:

When a wearer tries garments of one same kind and identically indicated sizes, he sometimes finds that some of them from one maker do not fit his physique in entirely the same way as others from another maker.

The above explicit recitation of Aisaka is in line with the ordinary person experience that the M size garment of one brand may fit a user while the M size garment of another brand may not fit the same user. It means in real life experience, the garment size indicator system of Aisaka referenced by the office action is explicitly acknowledged by Aisaka, and also well known by a person having ordinary knowledge in the art that the system may generate inconsistent results. Contrary, the claimed invention utilized a consistent process to compress the measurements of a human body into a compressed code. The

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same body measurements will always consistently generate the same code. It means the office action is using a system of imperfect performance in real world experience to support an obviousness rejection of an innovative system that always generates consistent results. The improvement of consistent results is another evidence of non-obviousness.

(E) Further evidences:

Step (d) of the Graham Inquiry requires a court or an examiner to fully consider the further supporting evidences provided by an applicant. The further evidences for supporting the independent claim 40 are summarized as follow:

(1) Unexpected result.

The subject claimed invention provided a new system allowing a person to present the BP code of a remote second person (a remote friend or relative), and to reliably buy a better fit garment (as compared with using the existing garment size indication system of Aisaka) for said second person. This unexpected result is not feasible for the standard garment size indicator system of Aisaka according to the problem mentioned in section (D)(3) Evidence (c) mentioned herein. The unexpected result had been recited in claims 24, 26, 27, 45 and 51. These claims had been forced to be withdrawn according to an election requirement of a previous office action. This unexpected result is officially supported by a 37 CFR 1.132 declaration submitted herein. The applicant respectfully requested any challenging of this unexpected result to be submitted in the form of an affidavit.

(2) Proper relationship between the claimed invention with the standard garment size indicators of Aisaka.

In fact, the subject application had identified the difference of the garment size indicator system of Aisaka by reciting the relationship between the subject claimed invention and the standard garment size indicator system of Aisaka. This relationship had been recited in claims 1, 2, 5, 7, 20, 25, 29, 32, 33, 34, 47, 48, 49, 50, 51, which had been withdrawn due to an election request. If the examination process include considering these withdrawn claims in conjunction

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with the existing pending claims, the examiner will find that the obvious issue is resolved because the ground of rejection will create conflict in reading the above mentioned withdrawn claims. The original purpose for an election is to avoid excessive searching loading of an examination process into an area outside the elected claims. In the present situation, the examination process had clearly crossed the territory of the elected claims and entered the area of the unelected claims. The office action is making use of the further characteristic of an unelected claim (the standard garment size indicator chart of Aisaka) to support the ground of rejection of the elected claims. Because of the reasons submitted above, the examiner is respectfully requested to allow the applicant to recall the withdrawn claims 1, 2, 5, 7, 20, 25, 29, 32-34, 47-51 into the list of claims to be examined.

(3) Level of skill for Speckova to perform dimensional measurement

In the declaration attached herein, the applicant inquires about the factual demonstration of the system of Speckova to be capable of performing dimensional measurement. If Speckova did not actually perform this measurement, the declaration inquires the level of skill required by a person to perform such measurement in order to support the ground of the rejection. The response of this enquiry should be provided in the form of an affidavit.

(4) Official notice that data compression, decompression and manipulation are well known in the art:

The examiner is respectfully directed to carefully evaluate the prosecution history of the subject application. In the office action dated 01/23/2006, the office action took an official notice that the feature of compressed code is an old expedient in the art. In applicant's response dated 05/17/2006, the applicant quoted precedent court ruling *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993) and 37 C.F.R. 1.107(b) to request the examiner to submit cited reference of the compression code or to provide an affidavit under 37 C.F.R. 1.107(b) about the level of skill to take the official notice stated. In the next office actions dated 08/18/2006 and 03/21/2008, the office action elected to present *Runton* as a supporting prior art. The applicant provided evidence in his response dated

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06/20/2007 why the teaching of Runton failed to teach the compression/decompression limitation claimed. The subsequent office action dated 09/25/2007 exchanged Runton with another prior art Powell to reject the characteristic of data compression claimed. In a telephone interview conducted on 10/30/2007, the examiner agreed that Powell failed to teach the compression/decompression limitation claimed. The office action dated 01/07/2008 exchanged Powell one more time with another prior art Aisaka to support the ground of data compression/decompression. Applicant's response dated 05/05/2008 submitted evidence to prove that Aisaka failed to teach the compression/decompression characteristic. The office action dated 12/16/2008 and applicant's response dated 04/15/2009 exchanged further opinions if Aisaka is a proper reference to support the process of compress and decompress human body measurements. Eventually the latest office action dated 07/30/2009 the office action provided the following recitation on page 5, last paragraph:

The examiner further gives official notice that the feature of a compressed body profile code is well-known and commonly used in the art.

The office action dated 07/30/2009, page 6 further recited that:

Regarding claim 52, since the m values are being compressed to produce a BP code by some process, it would be a matter of logic that a similar process could be used to decompress the code to provide the original input quantities. This process is merely arrives at the starting point of having m values, thus does not provide any useful result. The examiner further gives official notice that data compression, decompression and manipulation are well-known in the art.

It is obvious that the examination process now replaced Aisaka with an official notice to support the ground of rejection related to compress/decompress of human body measurement data. The examination process failed repeatedly to utilize prior arts Runton, Powell and then Aisaka, one after another to support the rejection of compressing/decompressing body measurements of a human body. Finally, in order to maintain the rejection the of compression/decompression limitation claimed, the office action now elected to go back to the "official notice".

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This is a situation exactly identical to the original starting point of 01/23/2008 of using the "official notice" to support the rejection of compression/decompression limitation claimed. The failure of seven rounds of office actions over three years, and the failure of three prior arts Routon, Powell and Aisaka, one after another to support rejection of the compression/decompression limitation claimed is a substantial evidence that the subject claimed invention is non-obvious. **This get back to the starting point style of looping examination process is "strongly objected"**. Since the "official notice" now presented had "already" been seriously traversed and failed, the official notice recited in the office action dated 07/30/2009 is respectfully requested to be withdrawn.

The latest office action indicated that the decompression process merely arrives at the starting point of having m values, thus does not provide any useful result. This is an evidence that the subject specification had not been throughout evaluated, including the evidence of unexpected results provided in the original specification. This allegation of the office action is not true because the specification had explicitly disclosed that after the compressed BP code of a customer (which may belong to a remote friend) is received by a retailer, the retailer is able to decompress the BP code to recover the original m values which faithfully describes the body profile of the customer. The retailer is then able to make use of these recovered m values to select the best fitted size of the garment ordered by the customer before the garment is shipped.

(5) Evaluating XL as a multiple digits compressed code:

The examiner is respectfully directed to section (C)(e) page 16 of applicant's response dated 05/05/2009 which proved that the size indication XL failed to become a multiple digit compressed code as claimed. Subsequent office action had **NEVER** rebuff about this important argument. The result of this argument is of substantial importance. This is because XL is a standard garment size indicator of similar nature to other garment size indicators such as S, M, L, 5 or 9 recited in the disclosure of Aisaka. If the office action failed to prove that XL squarely qualifies as a multiple digits compressed code claimed, then logically all other garment size indicators of similar nature will also failed to satisfy the

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limitation of "multiple digits compressed code as claimed" because they are of identical nature with the size indicator XL.

(6) Rejection of claims 6, 7, 9-18 and 49:

The examiner is respectfully directed to section (D), page 17 of applicant's response dated 05/05/2009, which requested the office action to provide cited reference to support ground of rejection of the subject claims, or to provide an affidavit under 37 C.F.R. 1.107(b) in lieu of the cited reference. Subsequent office action had **NEVER** provided response to this request. It is respectfully submitted that this request is a matter of law and must be fulfilled unless the examiner is able to provide law supported evidence explaining why the teaching of precedent court ruling In re Sun or the request made under 37 C.F.R. 1.107(b) is improper.

(F) Conclusion:

Listed below is a quotation of MPEP 707.07(f):

707.07(f) Answer All Material Traversed[R-3]

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

The examiner is respectfully requested to provide answers to each argument submitted herein, and make sure no traverse had been overlooked or ignored. If any material traversed is not honored, the examiner is respectfully requested to provide clear explanation, with quotation of supporting patent law, MPEP or precedent court ruling explaining why such rejection is proper. Concerning the discussion of sections (D)(1)(a) and (D)(1)(b) provided herein, the examiner is respectfully requested to wait for the result of the petition before issuing an office action. If new ground of rejection is added, the examiner is reminded not to make the next office action final. **[End of remark]**

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